

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	David C. Deaville et al.	Art Unit :	3653
Serial No. :	10/784,733	Examiner :	Gerald W. McClain
Filed :	February 23, 2004	Conf. No. :	2444
Title :	DOCUMENT STACKER WITH FAULT DETECTION		

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT OF AUGUST 27, 2007

Applicant's response to the restriction requirement mailed on August 27, 2007 is set forth below.

Applicant respectfully requests reconsideration of the restriction requirement.

In the event the requirement for restriction is made final, applicant petitions the Director under 37 C.F.R. § 1.144 to review the restriction requirement.

Background:

Following the filing of the application, the PTO issued a first restriction requirement on November 28, 2006. Applicant responded, without traverse, by electing the claims of Group I (claims 2-12 and 15-24) together with linking claims 1 and 14. Those claims included method and apparatus claims.

The PTO issued an Office action on the merits on January 23, 2007. Both method and apparatus claims were examined. In response to that action, the applicant amended the claims and, among other things, canceled independent claims 1 and 14 and submitted new independent claims 26 and 33.

The PTO then issued a second restriction requirement on August 27, 2007. The Examiner identified 4 groups of claims based on the original method claims, the original apparatus claims, the new method claims and the new apparatus claims. The action stated that "Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by the original presentation for prosecution on the merits." The action further stated that the new claims, including the sole pending independent

claims 26 and 33, were withdrawn from consideration as being directed to a non-elected invention.

The present restriction requirement is improper

Applicant submits that the restriction requirement is improper.

First, applicant was entitled to amend the claims in response to the non-final action of January 23, 2007. *See* 37 C.F.R. § 111.

Second, pursuant to MPEP § 803, a restriction requirement may properly be made if the claims are directed to independent or distinct inventions. However, if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits even though the include claims to independent or distinct inventions. *Id.*

Applicant submits that a comparison of the original claims with new independent claims 26 and 33 makes it clear that the restriction requirement, which effectively requires the applicant to prosecute only the original claims, is improper. Even if the new claims were considered to be directed to independent or distinct inventions (which applicant does not concede), applicant submits that there would not be a serious burden on the examiner to examine the claims presented for examination in response to the Office action of January 23, 2007.

The following chart presents side-by-side a comparison of claim 26 with original claims 1 and 7.

Pending claim	Original claim language	Original claim language
26. A machine-implemented method for use in connection with a document storage cassette comprising a document stacker that includes an actuator, the method comprising: measuring values of signals each of which is indicative of a respective load on the actuator during a document stacking	1. A method for use in connection with a document stacker comprising an actuator, the method comprising: sensing electric signals from the actuator during a document stacking operation; and	7. The method of claim 1 wherein sensing electric signals includes sensing signals indicative of actuator load

operation; comparing information about the measured values to a reference signal profile; and determining whether an expected event has occurred or whether an unexpected event has occurred based on the comparison.	determining whether an abnormal event has occurred based on the sensed signals.	and wherein determining whether an abnormal event has occurred includes comparing an actual profile of the actuator load with an expected profile.
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Applicant presented new claim 26 to more clearly define and claim the subject matter of the invention. It should be clear, however, that the applicant was entitled to amend the claims and there would be no serious burden to examine claim 26 and its dependent claims in the pending application.

Likewise, a comparison of claim 33 with original claims 14, 20 and 21 indicates that there would be no serious burden to examine claim 33 and its dependent claims in the pending application as well.

The following chart presents side-by-side a comparison of claim 33 with original claims 14, 20 and 21.

Pending claim	Original claim language	Original claim language	Original claim language
33. An apparatus comprising: a document stacker including: a cassette to store documents;	14. An apparatus comprising: a document stacker including: a cassette to store documents;	20. The apparatus of claim 13 [sic]	21. The apparatus of claim 19

<p>a piston operable to push a document into the cassette;</p> <p>an actuator operable to control movement of the piston; and</p> <p>first circuitry operable to measure values of signals indicative of a load on the actuator during a document stacking operation; and</p> <p>second circuitry coupled to the actuator to control operation of the actuator and coupled to the first circuitry,</p> <p>wherein the second circuitry is operable to compare information about the measured values to a reference signal profile and to determine whether an expected event has occurred or whether an unexpected event has occurred based on the comparison.</p>	<p>a piston to push a document into the cassette;</p> <p>an actuator to control movement of the piston; and</p> <p>first circuitry to sense electric signals from the actuator; and</p> <p>second circuitry coupled to the actuator to control operation of the actuator and coupled to the first circuitry to obtain signals indicative of how the actuator is functioning during a document stacking operation,</p> <p>wherein the second circuitry is adapted to determine whether an abnormal event has occurred based on the signals indicative of how the actuator is functioning.</p>	<p>wherein the electric signals are indicative of actuator load.</p>
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Furthermore, applicant submits there is no reason that both the method and apparatus claims presented in applicant's response to the January 23, 2007 Office action should not be examined together in the same application. The first Office action of January 23, 2007 already examined both the method and apparatus claims. Apparently the Patent Office determined that the original method and apparatus claims either were not directed to independent or distinct inventions, or if they were, there was no serious burden to examine both sets of claims in a single application. Accordingly, applicant respectfully requests that the Patent Office continue to examine both the method and apparatus claims in a single application.

Applicant further submits that the Examiner applied an incorrect standard in making the current restriction requirement. The restriction requirement of August 27, 2007 repeatedly refers to the groups of claims as being "independent or distinct" (*see, e.g.*, page 2, line 3; page 3, line 16). That is inconsistent with the standard set forth in the PTO's own rules. As stated in 37 C.F.R. § 1.145:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in § 1.143 and 1.144.

The Examiner's application of the looser standard, "independent or distinct," was improper.

For the foregoing reasons, applicant respectfully requests withdrawal of the current restriction requirement and examination of all claims presented in applicant's response to the January 23, 2007 Office action.


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Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 10/31/07



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